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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,181	10/05/2001	Dusan Miljkovic	700.03-US1	3749

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EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/972,181

Applicant(s)

MILJKOVIC, DUSAN

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,10-17 and 20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2,5-7,10-17 and 20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***Final Rejection***

**The Status of Claims**

Claims 1-2, 5-7, 10-17, and 20 are pending.

Claims 1-2, 5-7, 10-17, and 20 are rejected.

**Claim Rejections-35 USC 112**

1. Applicants' argument filed 2/1/05 have been fully considered but they are not persuasive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 1-2, 5-7, 10-17, and 20 under 35 U.S.C. 112, second paragraph, has been maintained due to applicants' failure to modify the claims according to the examiner's suggestion in the previous Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 5-7, 10-17, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 17, the phrase “ the oxidizable compound comprises at least one of a vicinal diol and a hydroxyl in vicinal position to a keto or O group ” is recited. This is vague and indefinite because the expression of the term “ comprising ” would imply that there are other components besides the diol and to the keto and/or O group present in the oxidizable compound. There is uncertainty as to what other groups are present in the oxidizable compound. Furthermore, since there is no elaborated concrete chemical structure / or chemical name for the oxidizable compound, this is absolutely indefinite. Therefore, an appropriate correction is required.

In claims 1 and 17 , the phrase “ an electrophile compound that comprises a group thirteen or group fourteen metal ” is recited. This is vague and indefinite because the expression of the term “ comprising ” would imply that there are other components besides the group thirteen or group fourteen metal present in the electrophile compound. There is uncertainty as to what other groups are present in the electrophile compound. Furthermore, since there is no elaborated concrete chemical structure/ or chemical name for the electrophile compound, this is absolutely indefinite. Therefore, an appropriate correction is required.

In claim 2 , the phrase “the oxidizable compound includes a structure according to structures 1-3 ” is recited. This is vague and indefinite because the expression of the term “ include ” would imply that there are other components besides the structures 1-3 present in the oxidizable compound. There is uncertainty as to what other groups are present in the oxidizable compound. Therefore, the examiner recommends to change from “include” to “ is selected from the group consisting of ”. Therefore, an appropriate correction is required.

In claim 2 , the phrase “ the substituted or unsubstituted alkyl, alkenyl, alkynyl, aryl, ary, alkaryl optionally include a heteroatom selected from the group consisting of O, S,N, Se ,and P ”is recited. This is vague and indefinite because the expression of the term “ include ” would imply that there are other components besides the O, S,N, Se ,and P present in the substituted or unsubstituted compound. There is uncertainty as to what other groups are present in the substituted or unsubstituted compound. Therefore, the examiner recommends to change from “include” to “ have”. Therefore, an appropriate correction is required.

### **Applicants' Argument**

2. Applicants argue the following issues:
  1. the claims as presently amended herein are directed to specific and defined compounds and the scope of the compounds in the claims should be readily ascertainable by a person of ordinary skill in the art .

The applicants' argument have been noted, but these arguments are not persuasive.

First, with respect to the applicant's argument, the Examiner has noted applicants' argument. However, the claims are still not well-defined unlike the applicant's assertion because the added claimed limitations, such as "the oxidizable compound comprises at least one of a vicinal diol and a hydroxyl in vicinal position to a keto or O group" and "an electrophile compound that comprises a group thirteen or group fourteen metal" contain the ambiguous term: "comprises"; furthermore, there are no specific and defined compounds and the scope of the compounds in the claims; especially, in claims 1 and 17. In addition, the second paragraph of 35 USC 112 requires that the claims particularly point out the subject matter that applicant regards as the invention. A claim referring to the specification is improper. Exparte Fressola, 27 USPQ 2d 1608 (US Pat. & Trade Mark Bd. Pat. App. & Int 1993).

Therefore, all the rejections are maintained.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Taylor Victor Oh*  
4/16/05

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